

## REMARKS

This paper responds to the office action dated October 3, 2008. Reconsideration is hereby requested in view of these remarks.

1. Status of the Claims

Claims 25-26, 29-34 and 37-40 remain pending in this application. Claims 25, 30-33, and 38-40 stand rejected under 35 U.S.C. § 103 as being obvious over Kraft (US 2002/0107009) in view of Cook (US 6,434,407). Claims 29 and 37 stand rejected under 35 U.S.C. § 103 as being obvious over Kraft in view of Cook and further in view of Schmidt (US 6,522,894). And Claims 26 and 34 stand rejected under 35 U.S.C. § 103 as being obvious over Kraft in view of Cook and further in view of Shimizu (US 2002/001236).

All of these rejections are traversed.

2. Independent Claims 25 and 33 are Patentable over Kraft in view of Cook

The obviousness rejection of independent claims 25 and 33 must be withdrawn for at least the following reasons: (A) Kraft does not disclose a “*safe volume profile providing a default volume setting selected to reduce risk of damage to a user's hearing*;” (B) Kraft does not *inherently* disclose the missing subject matter of the claims; and (C) the combination of Kraft and Cook would result in a device that outputs a *high volume* when used in speakerphone mode, contrary to the subject matter of claims 25 and 33.

- A) Kraft Does Not Disclose a “*safe volume profile providing a default volume setting selected to reduce risk of damage to a user's hearing*”

In the latest Office Action, the Examiner continues to allege that Kraft discloses the claimed “*safe volume profile providing a default volume setting selected to reduce risk of damage to a user's hearing*” by referring to paragraphs [0036] and [0037] of the reference, and now also relying on paragraphs [0022] and [0032] figures 1-2 and Table 1. As provided below,

however, these portions of Kraft do not teach or suggest the claimed “safe volume profile” and therefore the rejection is improper. (The Examiner also asserts that certain teaching *inherently* follows from these portions of Kraft – a point which is disputed by the Applicants in part 2.B, below.) Paragraphs [0022], [0032], [0036] and [0037] of Kraft read as follows:

**[0022]** Hands-free answer to a call may be included as a phone setting and may, together with several other settings, be used in a driving mode. Hands-free answer to a call may also be included in other modes, e.g. controlled by the detection of a head set.

**[0032]** Already at the present time, the CPU of the phone is capable of registering whether the phone is placed in a car kit holder, as the phone, when this is the case, automatically answers an incoming call, without the driver having to remove this hands from the wheel. This information is used in the preferred embodiment for initiating the driving mode, which, in addition to the hands-free function, may comprise diversion of data/fax calls, adjustment of ringing volume, sound volume and turning-on of display light.

**[0036]** The user may choose with the first item “selection” whether the mode selection is to take place manually or automatically. This is indicated by the box 27. If the user here selects automatic mode selection 28, the CPU checks the control parameters and selects mode in response thereto. The phone then returns to the main menu with the menu item “modes” display text (stage 25).

**[0037]** If manual mode selection is selected, it is asked in stage 29 which mode the user wants, and here “default” mode is suggested as default. If the user then selects this or another mode, the phone remains in this mode until another is selected or until the automatic mode selection is selected. The phone then returns to the main menu with the menu item “modes” display text (stage 25).

Paragraph [0022] of Kraft discloses that the “hands free” setting on Kraft’s telephone may be used when operating in the “driving” mode. Paragraph [0032] of Kraft discloses the

function of detecting when the telephone has been placed in a car kit holder in order to cause the telephone to automatically answer an incoming call without the driver having to remove his hands from the wheel. This paragraph also describes to the “driving” mode of Kraft’s telephone. Paragraph [0036] discloses the function of manually or automatically selecting from one of several modes that are programmed into the telephone. And paragraph [0037] discloses that when the phone is in “manual” mode, the user is able to manually put the phone into one of the available modes. The phone will then remain in this mode until another mode is manually selected, or until the user puts the phone back into automatic mode selection.

There is absolutely nothing whatsoever in these four paragraphs of Kraft that relates to the claimed *“safe volume profile providing a default volume setting selected to reduce risk of damage to a user’s hearing.”* In fact, there is no disclosure in Kraft that even relates to the concept of protecting the hearing of a mobile device user. This teaching is completely missing from Kraft because the telephone in Kraft does not include a loudspeaker that is capable of producing sufficient acoustic output to damage the user’s hearing – thus making the protection of the user’s hearing from such a speaker irrelevant to Kraft.

In claims 25 and 33, the claimed *“safe volume profile”* is used *“if the second speaker is operated in close proximity to the user’s ear while in the handsfree mode of operation,”* where the second speaker is a loudspeaker. Thus, a telephone like in Kraft that does not include a loudspeaker would have no need for the protection afforded by the claimed safe volume profile. In fact, this is why the portions of Kraft relied upon by the Examiner do not discuss potential damage to the user’s hearing, or a loudspeaker, or even generally refer to safely operating the telephone device under different acoustic settings.

Further proof that Kraft is completely irrelevant to protecting the user's hearing is evidenced in Tables 1 and 2 of Kraft. The Examiner referred to Table 1 of Kraft in the latest Office Action, but failed to reference Table 2. Table 1 provides a list of functions and phone setting options for Kraft's telephone. One of these options is listed as item 7: Sound Volume, and ranges from "level 1" to "level 5." It is evident from this table that "level 1" is a low volume setting and "level 5" is a high volume setting. Table 2, however, reveals that Kraft's telephone should be operated at a volume setting of "level 5" when in the "driving" mode, which as noted above, is Kraft's handsfree mode of operation. Therefore, Kraft discloses that the *highest* volume setting should be used in the handsfree mode, not a lower, safer volume setting that would be less susceptible to damaging the user's hearing.

Kraft clearly does not disclose the claimed "*safe volume profile providing a default volume setting selected to reduce risk of damage to a user's hearing,*" and therefore the obviousness rejection of claims 25 and 33 must be withdrawn.

B. Kraft Does Not Inherently Disclose the Safe Volume Profile

The Examiner now relies upon the doctrine of inherency in rejecting claims 25 and 33. This reliance is misplaced, however, because the subject matter of these claims does not *necessarily* flow from the teaching of Kraft as required to support a finding of inherency. To the contrary, the teaching of Kraft leads to the opposite conclusion from that made by the Examiner.

Inherency requires more than proof of possibility or desirability. To support a conclusion of inherency, the Examiner must prove *necessity*. If the element is not necessarily present, then that element is not inherent. (*See MEHL/Biophloie Int'l. Corp. v. Milgraum*, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305 (Fed. Cir. 1999) (involving inherency in anticipation: "Under principles of inherency, if the prior art necessarily functions in accordance with or includes, the

claimed limitation, it anticipates.”) The MPEP is clear on the limitations of the doctrine of inherency, stating that there must be facts or technical reasoning that supports “the determination that the allegedly inherent characteristic *necessarily flows* from the teachings of the applied prior art.” (MPEP § 2112 (IV)) (emphasis added). Here, there is not only a complete lack of facts supporting the Examiner’s conclusion of inherency, but the reference itself teaches the *opposite* of the allegedly inherent subject matter.

At page 2 of the Office Action, the Examiner now asserts that Kraft discloses “‘the safe volume profile providing a default volume setting selected’ and inherently of reducing the risk of damage to a user’s hearing” (par [0010, Table-1; 0032; 0020])/volume with predetermined by user level of normal and hand’s free and thus it is inherent of such prevention of damaging of user’s hearing).” On page 3 of the Office Action the Examiner also refers to certain subject matter being “inherent” or “inherency” in comparing the claimed subject matter to Kraft. These conclusions, however, are not supported by any facts or technical reasoning that would establish that the claimed subject matter *necessarily flows* from Kraft. Although Kraft may disclose different operating modes, there is no indication that Kraft is concerned with damage to the user’s hearing in any of these modes, and in fact teaches that when the telephone is in the handsfree mode the *highest* volume setting should be used. Thus, far from *necessarily flowing* from the teaching of Kraft, the “*safe volume profile*” of claims 25 and 33 is something completely different from the teaching of the reference. The Examiner’s inherency findings are not supportable.

For this additional reason the obviousness rejection over Kraft in view of Cook must be withdrawn.

C.     The Combination of Kraft and Cook Results in a Device that  
Outputs a “high volume” When Used in Speakerphone Mode

Finally, the Examiner concludes that the combination of Kraft and Cook would render the claims obvious because the person of ordinary skill in the art would have modified Kraft to include a first and second speaker, where the second speaker was the loudspeaker from Cook. This conclusion is wrong, however, because both Kraft and Cook teach that the speaker should be at maximum volume when in handsfree mode, thus resulting in a device that fails to reduce the risk of damage to a user’s hearing.

As shown above, Kraft discloses a “driving” mode in which the telephone is used in a handsfree mode of operation. According to Table 2 of Kraft, when the telephone is in the driving mode, the volume setting stored in the telephone is set to level 5 – the highest volume setting. Likewise, Cook teaches a speakerphone for handsfree operation in which the speakerphone is operated “at a relatively high volume level” (Cook, col. 1, ll. 19-21) and “by projecting relatively high-volume sound waves” (Cook, col. 2, ll. 21-22) and “must project sound waves at relatively high volumes (Cook, col. 3, ll. 33-34).

Therefore, if the person of ordinary skill in the art were to combine Kraft with Cook, the result would be a device that outputs a “high volume” when used in the speakerphone mode. In this hypothetical device, protection of the user’s hearing would not be an issue because neither Kraft nor Cook include any disclosure or suggestion that this is even a problem to be addressed. Rather, both Kraft and Cook disclose using high volume settings when in the speakerphone or handsfree mode of operation, thus potentially leading to the exact type of hearing damage that the present invention is aimed at preventing.

For this additional reason the conclusion of obviousness is faulty and must be withdrawn.

3. The Office Action Provides No Rationale to Support the Rejections of Dependent Claims 26, 29, 32, 34, 37, and 40

The obviousness rejections of claims 26, 29, 32, 34, 37 and 40 must be withdrawn because the Office Action fails to set forth any articulated reasoning to support the legal conclusion of obviousness. Applicants raised this same issue in response to the last Office Action, but the Examiner has not provided any additional reasoning or rationale to support his bald conclusions of obviousness for these dependent claims. The Examiner must provide this analytical support for the rejections, or the rejections must be withdrawn.

As stated in MPEP 2141, “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” (See *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), stating that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”)

Regarding claims 29 and 37, for example, the Office Action at page 8 admits that the subject matter of these claims is not disclosed in Kraft and therefore relies upon Schmidt as allegedly providing the missing teaching. In concluding that the claims are obvious, however, the Office Action merely repeats the portions of the *claim language* that are allegedly present in Kraft and Schmidt. There is no analysis, no reasoning, and no rationale in support of the conclusion of obviousness. This is exactly the type of “mere conclusory statements” that the Supreme Court said could *not* sustain a rejection based on obviousness. The Office Action repeats this same type of “mere conclusion” in finding that claims 26, 32, 34 and 40 are obvious. Therefore, the obviousness rejections of these claims must be withdrawn because all of these rejections lack any articulated reasoning or rationale in support of the conclusion of obviousness.

This application is now in condition for allowance.

Respectfully submitted,  
JONES DAY

A handwritten signature in cursive script, reading "David B. Cochran". The signature is written in dark ink and is positioned above a horizontal line.

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